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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,356	12/17/2004	Tokutomi Watanabe	47233-0048	8100
55694 7590 01/27/2009 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
STULIL, VERA				
ART UNIT		PAPER NUMBER		
1794				
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01/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/518,356

Applicant(s)

WATANABE ET AL.

Examiner

VERA STULII

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2008 has been entered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim13, and 15-35 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. 13, and 15-35.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, and 15-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is rendered indefinite and non-enabling for the recitation of the phrase "tea leaf extract is included in the drink in an amount of 0.01% to 3% by weight relative to the total volume of the drink". It is noted that on page 8 second paragraph of the Specification, Applicants disclose that "it is suitable to use the extract in an amount of 0.01% to 3% by weight, particularly preferably 0.02% to 1% by weight (calculated on the tea-derived soluble solid content) relative to a product (drink) to ensure a foam-producing property in terms of influences on cost efficiency and aroma, etc". It appears that the amendment to the claim 13 did not change the range of 0.01% to 3%, but changed the definition of the range from the percent by weight of tea-derived soluble solids relative to the total volume of the drink to the percent by weight of tea extract relative to the total volume of the drink. Those appear to be substantially different ranges. For instance, example 5 and 6 (pages 18 and 19 of the specification demonstrate 1000 ml of drink containing 3.5 g of black tea extract which contains 0.42 g of soluble solids. Then, the percent by weight of tea-derived soluble solids relative to the total volume of the drink is 0.042%. The percent by weight of tea extract relative to the total volume of the drink is 0.35%. Therefore there is approximately a ten-fold difference between these two ranges. It appears that the range definition limitation that is now cancelled is supported by the specification (page 8 second paragraph). It also appears that the range definition limitation that is currently recited in claim 13 is not supported by

the specification and was not intended to be used as a range for the tea extract amounts. Clarification or correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13, 15-16, 18-30 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (CN 1237624) in view of Tarkmishvili et al.

In regard to claims 13, 23 and 26, Liu discloses a carbon dioxide containing beverage that is formed from tea (tea extract), wine, liquor, fruit juice, white granulated sugar, sweetening agent, carbon dioxide, foaming agent, thickening agent, etc. (Abstract). Regarding the tea extract recitations, it is noted that Liu discloses tea juice extract (1:15 ratio of tea leaves to water) (page 1 bottom paragraph).

In regard to claims 13, 15-16 and 30, Liu does not disclose various specific characteristics of the foam-holding properties as recited.

Tarkmishvili et al disclose a novel foaming agent from tea extract which could replace egg white in the production of zefir (foamy confectionery product) and replace it entirely in the production of soufflé. Tarkmishvili et al disclose that the extract is made from "current types of tea leaves". Egg whites were well known in the art to be used in the foamy confectioneries for foam formation and foam holding properties. Therefore, as disclosed by Tarkmishvili, tea extract possesses similar foam formation and foam holding properties to whipped egg whites. Therefore, one of ordinary skill in the art

would have been motivated to use tea extract as a foam forming and foam holding agent. In regard to various foam-holding properties as recited in claims 13, 15-16 and 30, it is noted that although the combination of references do not specifically disclose every possible quantification or characteristic of its product, such as specific characteristics of the foam-holding properties, this characteristics would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The reference discloses the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of ordinary skill in the art would recognize that the specific characteristics of the foam-holding properties, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable reading of the teachings of the reference has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

In regard to claims 13, 23 and 27, Liu discloses the following amounts of beverage components (page 1 bottom paragraph, page 2 top paragraph):

- 100 kg of tea juice extract (1:15 ratio of tea leaves to water);
- 800-1000 L of water;
- 50-120 L of grape wine;
- 10-90 L of distilled spirit;
- 100-200 L of fruit juice;

- 50-100 kg granulated sugar;
- 0.1-0.2 g/kg of sodium benzoate;
- 0.5-1 g/kg of vitamin C;
- foaming agent;
- 0.1-0.2 g/kg polyphosphate;
- colorant;

Liu is silent regarding the amount of tea solids in the tea extract. One of ordinary skill in the art would have been motivated to vary the amount of tea extract, if at all necessary, depending on a desired color, taste, and foaming properties. The amount of tea extract would depend on the form of the extract (liquid, solid, powdered, etc), amount of solvent in the extract, amount of other ingredients in the extract, etc. One of ordinary skill would also have been motivated to vary amount of tea extract in the beverage depending on personal preferences of a consumer based on such factors as color of the beverage, taste (more or less bitter), amount of foam, etc. The amount of tea extract is therefore seen to have been an obvious result effective variable, routinely determinable. Further in this regard, Applicants are referred to the rejection under 35 U.S.C. 112, as stated above.

Regarding claims 18 and 32, Liu do not disclose particular type of tea. Given the fact that both green tea and black tea types were well known in the art to be used for tea beverages preparation, one of ordinary skill in the art would have been motivated to choose a particular type of tea based on a personal preferences of a consumer, such as

color, flavor, taste, etc. The particular choice of tea would therefore have been an obvious result effective variable.

Also in regard to claim 19, 24-25 and 28-29, Liu do not specifically disclose particular internal pressure of carbon dioxide. However, one of ordinary skill in the art would have been motivated to vary amount of carbon dioxide incorporated depending on a desired mouthfeel, fizz and flavor.

In regard to claims 20-22 and 33-35, Liu discloses wine, distilled spirit and fruit juice. In regard to claims 20 and 33, Liu discloses a beverage that does not contain fermented grain liquor. In regard to claims 21 and 34, Liu discloses carbonated low-alcoholic fruit drink (page 1 bottom paragraph, page 2 top paragraph). In regard to claim 22 and 35, Liu discloses carbonated low-alcoholic fruit drink having an alcohol content of less than 12% (page 1 bottom paragraph, page 2 top paragraph).

Claim 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (CN 1237624) in view of Tarkmishvili et al as applied to claims 16 and 26 above, and further in view of Gong Yungao (CN 1285153).

Liu and Tarkmishvili et al are taken as cited above. Liu discloses that tea beverage is a refreshing drink that prevents fatigue and regulates appetite.

Liu does not disclose use of hop extract.

Gong Yungao disclose tea beverage "with medical health care" action containing hops and tea leaf extract. Gong Yungao discloses that the finished product prevents hypertension, regulates metabolism, and has a good taste.

Since Liu discloses tea beverage with beneficial properties for human health, and since Gong Yungao discloses tea beverage in combination with hops that prevents hypertension, regulates metabolism, and has a good taste, one of ordinary skill in the art would have been motivated to modify Liu in view of Tarkmishvili et al and to include hop extract as an ingredient for the benefits taught by Gong Yungao. One of ordinary skill in the art would have been motivated to do so, since both tea and hops are known to impart bitter flavor to beverages. One of ordinary skill in the art would also have been motivated to do so, since hops were well known in the art to be used in preparation of effervescent beverages.

Response to Arguments

In response to Applicants arguments regarding the rejection under 35 U.S.C. 112, second paragraph, Applicants are referred to the rejection as stated above.

Applicants' arguments with respect to the rejection under 35 U.S.C. 103(a) as being unpatentable over Liu (CN 1237624) have been considered but are moot in view of the new ground(s) of rejection (pages 2-5 of the Remarks).

Applicant's arguments, see pages 5-6 of the Remarks, with respect to the rejection under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (JP 04356160) have been fully considered and are persuasive. The rejection has been withdrawn.

In response to applicants' arguments regarding amounts of tea leaf extract, Applicant is referred to the rejections as stated above (see pages 2-4 of the Remarks).

Applicants' argument that "*Liu* is silent to any foam-holding property, and fails to recognize that tea extract can provide increased foam-holding" is moot in view of the new ground(s) of rejection (page 4 of the Remarks).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JENNIFER MCNEIL can be reached on (571)272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/
Primary Examiner, Art Unit 1794

VS